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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,298	08/08/2001	Vincent Bryan	46739/262600	3319

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EXAMINER

PRIDDY, MICHAEL B

ART UNIT PAPER NUMBER

3732

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,298

Applicant(s)

BRYAN ET AL. 

Examiner

Michael B Priddy

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44, 56-61, 64-67, 70, 71, 74-76, 81-96, 101-103, 106-110 and 112-122 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-44, 56-61, 66, 67, 70, 71, 75, 76, 81-94, 96, 110 and 114-120 is/are allowed.
- 6) ☒ Claim(s) 64, 65, 74, 95, 101-103, 106-109, 112, 113, 121 and 122 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 64 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Büttner-Janz (U.S. 5,401,269). Büttner-Janz teaches a bone joint implant comprising a central body 3 positioned between two shells 1 & 2, wherein each shell 1 & 2 has a relatively smooth inner surface that contacts the central body 3 and at least one shell 1 & 2 has a centralized motion constraint protuberance 13; wherein the inner surface is shaped to articulate with at least a portion of the central body 3.

Claim 74 is rejected under 35 U.S.C. 102(e) as being anticipated by Norton (U.S. 6,533,817). Norton et al. teaches a bone joint implant comprising at least two opposing shells, a central body disposed between the two opposing shells, and at least one opening which could be sealed and could allow for the introduction of a lubricant into the implant after the implant has been assembled.

Claim 95 is rejected under 35 U.S.C. 102(e) as being anticipated by Ray et al. (US 2002/0183848). Ray et al. teaches a bone joint implant comprising an encapsulated central body 22 that, in one state, is impregnated with water which improves its surface lubricity.

Claims 101-103, 106, 121 and 122 are rejected under 35 U.S.C. 102(b) as being anticipated by Parsons et al. (U.S. 5,545,229). Parsons et al. teaches a bone joint implant comprising a central body 2 positioned between two shells 8 & 10, wherein the central body 2 has a polymer coating 4 thereon, and the polymer 4 is a slightly elastomeric biocompatible polymeric material.

Claims 112 and 113 are rejected under 35 U.S.C. 102(b) as being anticipated by Parsons et al. (U.S. 5,545,229). Parsons et al. teaches a bone joint implant comprising a central body 4 having a coating 8/10 thereon characterized in that the coating material is the same as the material used to form the central body 4 yet has a different hardness from the material used to form the central body 4. In lines 1-2 of column 5, Parsons et al. discloses the material used to form the "coating" 8/10 includes "more rigid elastomers of the same type as used in the disc 2/4 itself."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 107 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. Parsons et al. teaches a bone joint implant comprising a central body 2 positioned between two shells 8 & 10, wherein the central body 2 has a polymer coating 4 thereon. Hence Parsons et al. teaches all of the limitations of the present invention except that the polymer coating 4 is selected from the group consisting of Chronothane, Chronoflex, Elast-Eon II, Bionate, CarboSil-10, Tecothane, Tecoflex, and Carbothane. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the polymer coating 4 of Parsons et al. of one of these materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 108 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. Parsons et al. teaches a bone joint implant comprising a central body positioned between two shells, wherein the central body has a polymer coating thereon. Hence Parsons et al. teaches all of the limitations of the present invention except the coating polymer coating thickness is from about 2 mil to about 5 mil. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the polymer coating of Parsons et al. such that it had a thickness of from about 2 mil to about 5 mil, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Art Unit: 3732

Allowable Subject Matter

Claims 1-44, 56-61, 66, 67, 70, 71, 75, 76, 81-94, 96, 110 and 114-120 are allowed.

Response to Arguments

Applicants' arguments, filed 09/16/2004, with respect to claim 103 have been considered but are moot in view of the new ground(s) of rejection.

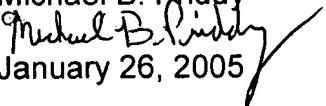
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B Priddy whose telephone number is (571) 272-4717. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4717. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael B. Priddy

January 26, 2005